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10/784,530

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Ashvin Joseph Mathew

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03/19/2008

SENNIGER POWERS LLP (MSFT)  
ONE METROPOLITAN SQUARE, 16TH FLOOR  
ST. LOUIS, MO 63102

EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

NOTIFICATION DATE

DELIVERY MODE

03/19/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/784,530 | <b>Applicant(s)</b><br>MATHEW ET AL. |  |
|                              | <b>Examiner</b><br>DOUGLAS B. BLAIR  | <b>Art Unit</b><br>2142              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 18 is directed towards the method of claim 1. The claimed media do not limit the method of claim 18 but instead implement the method of claim 18. The claimed media provide no limiting value to the claimed process.

Claim 27 is objected to because of the following informalities: it refers to the system of claim 1 instead of claim 19. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 7,188,252. Although the conflicting claims are not identical, they are not patentably distinct from each other because they '252 patent claims essentially the same invention as the current application with only a broader scope.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The media in claim 18, even if claimed properly, would not be statutory because the media is described in the applicant's specification on page 47 as possibly being program modules and data structures or modulated data signals. Program modules, data structures, and modulated signals do not fit into any of the statutory categories of inventions.

Claims 33-40 are directed towards the same media and are thus also non-statutory. Claims 19-32 are directed towards a system comprising a server and a database. The applicant's specification does not clearly define a server as being a hardware element therefore the term server is given the normal interpretation in the art as a program capable of receiving socket connections from clients. Since the system of claim 19-32 only comprises software it does not fit into any of the statutory categories of invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-3, 5-6, 11, 15-21, 23-24, 27, 31-34, 36, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication Number 2002/0120866 by Mitchell et al (Part of applicant's IDS).

As to claim 19, Mitchell teaches an authentication system comprising: an authentication server coupled to a data communication network (**Figure 1**); an authentication database associated with the authentication server (**Figure 1**), said authentication database being configured to store authentication information for comparison to login information provided by a user for authenticating the user (**paragraph 20**), said authentication database further being configured to store user-specific information identifying the user with respect to one or more services provided by at least one affiliate server coupled to the data communication network (**paragraph 20**), said affiliate server being configured to provide the one or more services to the user via a client coupled to the data communication network (**paragraph 24**); said authentication server being configured to receive a request from the user for a service to be provided by the affiliate server, said authentication server further being configured to authenticate the user responsive to the request when login information retrieved from the user via the data communication network matches the authentication information stored in the authentication database (**paragraphs 24-25**); said authentication server being further configured to maintain a

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user profile storing the user-specific information, to receive a request from the requested service for user information associated with the user and consent to use the requested user information, to determine if the requested user information is stored in the user profile in response to the request for consent (**paragraphs 33-34**); and said authentication server being further configured to provide a user interface to collect the requested user information that is not stored in the user profile from the user, to receive the user information provided by the user via the user interface in response, and to allow access by the requested service to the received user information (**paragraph 32**).

As to claim 20, Mitchell teaches the system of claim 19, wherein the authentication server is configured to update the user profile with the received user information (**paragraph 32**).

As to claim 21, Mitchell teaches the system of claim 19, wherein the authentication server is configured to allow, in response to the request for consent, access by the requested service to the requested user information if the user information is stored in the user profile (**paragraph 38**).

As to claim 23, Mitchell teaches the system of claim 19, wherein the user interface provided by the authentication server displays a user-selectable option for viewing intention information associated with the requested user information, said intention information describing how the requested user information will be used by the requested service (**paragraph 30**).

As to claim 24, Mitchell teaches the system of claim 23, wherein the authentication server is configured to provide an intention user interface for displaying the intention

information, said intention user interface being provided by the authentication server in response to the user-selectable option being selected by the user **(paragraph 30)**.

As to claim 27, Mitchell teaches the system of claim 19, wherein the requested service is granted consent to use the user-specific information stored in the user profile **(paragraph 30)**.

As to claim 31, Mitchell teaches the system of claim 19, wherein the authentication server is configured to provide an administrator user interface to a responsible person of the user in response to the received user information, said administrator user interface allowing the responsible person of the user to grant consent for the requested service to use the received user information **(paragraphs 43-44)**.

As to claim 32, Mitchell teaches the system of claim 31, wherein the authentication server is configured to allow access by the requested service to the received user information if consent for the requested service to use the received user information is granted by said responsible person **(paragraphs 43-44)**.

As to claims 1-3, 5-6, 11-12, and 15-18, they are directed towards the method implemented by the system of claim 19 and its dependents and are therefore rejected for the same reasons.

As to claims 33-34, 36, and 40, they are directed towards media that is part of the system of claim 19 and its dependents and are therefore rejected for the same reasons.

Claims 1-3, 5-6, 11, 15-21, 23-24, 27, 31-34, 36, and 40 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. As illustrated in

the 102(b) rejection previously presented in this action, Mitchell teaches the applicant's claim language word for word in a document published over a year before the applicant filed their application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 8-10, 12-14, 22, 26, 28-30, 35, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 2002/0120866 by Mitchell et al. in view of U.S. Patent Application Number 2002/0023059 by Bari et al (Part of applicant's IDS).

As to claims 4, 22 and 35, Mitchell teaches the system of claim 19, however Mitchell does not explicitly teach a system wherein the user interface provided by the authentication server displays the user-specific information previously stored in the user profile.

Bari teaches a system wherein the user interface provided by the authentication server displays the user-specific information previously stored in the user profile (paragraph 44 and Figures 9A-D).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Mitchell regarding a user authorization system



with the teachings of Bari regarding displaying user specific information previously stored because doing so allows a user to easily change previously entered information.

As to claims 8-10, 26, and 38, Mitchell teaches the system of claim 24, however Mitchell does not explicitly teach wherein the requested service is a member of a policy group, and wherein said intention user interface further displays a list of members of said policy group.

Bari teaches a system wherein the requested service is a member of a policy group, and wherein said intention user interface further displays a list of members of said policy group (paragraph 43).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Mitchell regarding a user authorization system with the teachings of Bari regarding displaying a list of affiliates because a list allows a user to more easily select who to provide information to.

As to claims 9 and 10, Bari teaches a method wherein said intention user interface further displays a second user-selectable option for viewing a privacy policy associated with said policy group, said privacy policy relating to how user information that the policy group is granted consent to use is to be protected and providing a policy user interface via the browser for displaying the privacy policy, said policy user interface being provided in response to the second user-selectable option being selected by the user (paragraph 44).

As to claims 12-14, 28-30, and 39, Mitchell teaches claims 11, 27, and 33 including revoking consent (see paragraphs 46-47); however Mitchell does not explicitly teach list services. Bari teaches listing services that a user may want access to (paragraph 43). It would

have been obvious to combine the teachings of Mitchell and Bari for the reasons given in the rejections of claims 8, 26, and 38 above.

Claims 7, 25, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 2002/0120866 by Mitchell et al. in view of U.S. Patent Application Number 2005/0076233 by Aarts et al (Part of applicant's IDS).

As to claims 7, 25, and 37, Mitchell teaches the system of claim 24, however Mitchell does not explicitly teach wherein said intention user interface further displays retention information associated with the requested user information, said retention information specifying how long the requested user information will be retained by the requested service.

Aarts teaches a system wherein said intention user interface further displays retention information associated with the requested user information, said retention information specifying how long the requested user information will be retained by the requested service (paragraph 30).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Mitchell regarding a user authorization system with the teachings of Aarts regarding retention periods for data because a user may only want to release information for a certain period of time (Aarts, paragraph 30).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/  
Examiner, Art Unit 2142

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